

Remarks

This Reply is in response to the June 15, 2009 Office Action ("Office Action") issued in connection with the above-identified patent application. Reconsideration of the application in view of the following remarks is respectfully requested.

Summary of the Office Action

Claims 200-219 were pending in this application.

Claims 200-202, 206-212, and 216-219 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,485,221 ("Banker") in view of U.S. Patent No. 5,754,730 ("Windrem").

Claims 203 and 213 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Banker in view of Windrem and U.S. Patent No. 6,052,145 ("Macrae").

Claims 204 and 214 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Banker in view of Windrem and U.S. Patent No. 5,986,650 ("Ellis").

Claims 205 and 215 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Banker in view of Windrem and U.S. Patent No. 5,650,827 ("Tsumori").

Summary of the Applicants' Reply

The Examiner's rejections of claims 200-219 are respectfully traversed.

Reply to the Rejections

Claims 200-202, 206-212, and 216-219 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Banker in view of Windrem. Claims 203 and 213 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Banker in view of

Windrem and Macrae. Claims 204 and 214 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Banker in view of Windrem and Ellis. Claims 205 and 215 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Banker in view of Windrem and Tsumori. The rejections of claims 200-219 are traversed.

The present invention, as defined by independent claim 200, relates to a system for allowing a user of an interactive media guide to watch a program on a viewing device while simultaneously recording another program on a digital storage device. One of the elements recited in claim 200 is an interactive television program guide implemented on user television equipment that is configured to perform, among other things, each of the following elements:

- cause said first tuner to tune to a channel corresponding to said first television program in order to cause said first television program to be displayed by said viewing device; and
- cause said second tuner to tune to a channel corresponding to said second television program in order to cause said second television program to be recorded by said digital storage device,
- wherein broadcast times of said first television program and said second television program overlap such that said first television program is displayed by said viewing device at the same time that said second television program is recorded by said digital storage device.

Thus, according to claim 200, the interactive program guide causes two different tuners to tune to two different overlapping television programs for viewing and recording to a digital storage device.

In the Office Action, the Examiner has combined two references, Banker (which incorporates by reference U.S. Patent No. 5,592,551 ("Lett")) and Windrem, to reject claims 200-202,

206-212 and 216-219. Applicants respectfully traverse the rejections.

Although Banker states that simultaneous watch and record and picture-in-picture capabilities could be provided using "multiple tuners," there is no enabling discussion of how such tuners would be controlled as is required by applicants' claims. (Banker, col. 9, lines 37-39). In the Office Action at page 9, the Examiner states that only the mere disclosure of multiple tuners in Banker is needed. M.P.E.P. § 2121, however, requires that prior art be enabling. Banker instead only mentions that multiple tuners may be provided, without any further details. (Banker, col. 9, lines 37-40). Even if Banker's multiple tuners were operable, which is not conceded, Lett does not describe how multiple tuners could be controlled. Like Banker, Lett briefly mentions using multiple tuners for picture-in-picture services or watch/record modes, but also fails to disclose how multiple tuners would operate. (Lett, col. 7, lines 26-28). In particular, Lett fails to disclose that multiple tuners could be controlled by an interactive guide.

Lett and Banker both describe a data port 140 which may be used by a microprocessor for communication and control of other auxiliary devices. (Lett, col. 9, lines 59-61, Banker, col. 12, lines 5-7.) Banker's single discussion of providing simultaneous viewing and recording uses its data port to combine two separate subscriber terminals in a master/slave relationship. (Banker, col. 16, lines 24-25.) Lett and Banker both state that the data port "may accommodate an IR blaster for VCR control via an on-screen menu, an additional subscriber terminal for dual tuner operation, or connection to a digital video subscriber terminal." (Lett, col. 9, lines 61-65, Banker, col. 12, lines 7-10.) Notably, Lett and Banker do not disclose how to control additional subscriber terminals for dual tuner operation via the data port. In particular, neither Lett nor Banker disclose

using an interactive guide to control the additional subscriber terminals for dual tuner operation. In fact, Banker fails to disclose controlling any tuner with an interactive guide and Lett only discloses controlling a single tuner with an interactive guide. There is simply no disclosure in Banker or Lett of how an interactive guide could control multiple tuners. Therefore, a combined Lett and Banker system fails to disclose an interactive television program guide that is configured to perform at least the following steps specified in claim 200:

- cause said first tuner to tune to a channel corresponding to said first television program in order to cause said first television program to be displayed by said viewing device; and

- cause said second tuner to tune to a channel corresponding to said second television program in order to cause said second television program to be recorded by said digital storage device,

- wherein broadcast times of said first television program and said second television program overlap such that said first television program is displayed by said viewing device at the same time that said second television program is recorded by said digital storage device.

Further distinguishing claim 200 from the combination of Lett and Banker is the digital storage device element. In the Office Action at page 4, the Examiner acknowledges that Banker does not explicitly recite a digital storage device. To fill this deficiency, the Examiner states that Windrem is analogous art which could be used for recording television content as a substitute for Banker's VCR. Applicants respectfully disagree. Windrem describes cache management and disk utilization for a digital video recorder. (Windrem (col. 1, lines 46-47). There is no disclosure in Windrem that suggests that it could be used as a substitute for a VCR. Indeed, the Examiner has failed to state any motivation for combining

Windrem with Banker and Lett. Windrem's system is described as being for random access disk drive which provide random access to video data. (Windrem, col. 1, lines 16-20.) Windrem contrasts this with a tape recorder which allow only sequential access. (Windrem, col. 1., lines 18-19.) Banker and Lett disclose a VCR as their recording device. There is no disclosure in Banker and Lett of anything other than a standard single tape recorder that provides recording functionality. As such, a person of skill in the art would not read Windrem's caching techniques and multiple video inputs and outputs as being relevant to a VCR that records video on a tape, which does not have caching or random access functionality. Applicants submit that such video data cache management systems would not have been an obvious substitution for a VCR at the time of the invention. Thus, the combination of Lett, Banker and Windrem do not disclose all of the elements of claim 200.

For at least the reasons discussed above, applicants submit that claim 200 is patentable over the combination of Lett, Banker and Windrem. Claim 210 includes elements in common with claim 200 and is patentable over the references for the same reasons. Each of the dependent claims 201-209 and 211-219 are also patentable for at least the same reasons. Accordingly, all of the rejections of the pending claims should be withdrawn.

Conclusion

For at least the reasons set forth above, applicants respectfully submit that this application is in condition for allowance. Prompt consideration and allowance of this application are respectfully requested.

Respectfully submitted,

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